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Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number CQ10212	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 10/674,422	Filed October 1, 2003	
	First Named Inventor David M. HILBERT		
	Art Unit 2166	Examiner Usmaan SAEED	
MOUNTAIN VIEW OFFICE 23493 CUSTOMER NUMBER			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons stated on the attached sheets. Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number 37,771</p> <div style="text-align: right;"> _____ Signature</div> <div style="text-align: right;"> _____ Joseph Bach Typed or printed name</div> <div style="text-align: right;"> _____ (650) 625-8100 Telephone number</div> <div style="text-align: right;"> _____ January 3, 2007 Date</div>			

JAN 03 2007**PATENT APPLICATION****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: CQ10212

David M. HILBERT, et al.

Appln. No.: 10/674,422

Group Art Unit: 2166

Confirmation No.: 5644

Examiner: Usmaan SAEED

Filed: October 1, 2003

For: CONTEXT-BASED CONTACT INFORMATION RETRIEVAL SYSTEMS AND
METHODS**PRE-APPEAL BRIEF REQUEST FOR REVIEW****MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated October 3, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

REMARKS

Claims 3-19, 22-24, and 26-40, are all the claims pending in the application. Claims 3-5, 7-10, 13, 15, 16-19, 22-24, 26, 28-29, 31, 34-36 and 38-40 stand rejected under 35 USC 103 as being unpatentable over Kubota (USP 6,041,323) in view of Polnerow (USP 5,813,006). Claims 6, 11, 12, 14, 27, 32, 33, and 37 stand rejected under 35 USC as being unpatentable over Kubota, in view of Polnerow, and further in view of Lamburt. The undersigned has conducted a telephonic interview with the Examiner and his Supervisor, during which the undersigned has explained the deficiencies of the pending Office Action. However, the Examiner refused to acknowledge these deficiencies and, consequently, the Supervisor has opined that Applicant should file an Appeal in this matter. Accordingly, Applicants submit the following remarks

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which highlight the deficiencies as explained to the Examiner and his Supervisor, and request that the pending rejection be reversed.

I. The claimed invention

The subject invention can be understood from the following explanation with reference to Figure 9, which illustrates an embodiment of the invention wherein a user is viewing a document 210 (in this example a webpage). While the user views the document, the system scans the document to check whether it contains any term that relates to a contact, such as a name, a zip code, a phone number, etc. When the system finds such a term, it checks the user's contacts database (e.g., Outlook Contacts) to see whether a match exists. If so, the system displays the matched contacts unobtrusively, without interrupting the user's activity. In the Example of Figure 9, the webpage 210 includes three company names (212) which were identified by the system. The system then matched the company names to entries in the user's contact database and displayed the matches unobtrusively, as shown in window 240.

Independent claims 22 and 36 recite such a system, while independent claim 39 recites the corresponding method. Other features are recited in the independent claims; however, for the purpose of this Request, the rejection of only the independent claims will be discussed. Moreover, since the Examiner applied a detailed rejection only to claim 36, only the detailed rejection of claim 36 is addressed in detail herein.

II. The Cited References

i. Kubota

Kubota discloses a computerized search engine, much like popular internet search engines, e.g., Yahoo, Google, etc. The Examiner cited Figure 11, which depicts the user interface. As explained in Kubota, the user enters a search term in window 901, whereupon the system searches the database for matching documents. The titles of the matched documents are displayed in window 927, while the body of the best matching document is also displayed in window 907. The user may highlight other documents in window 927 to display them in

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window 907. The user interface also has a clickable icon 947, enabling the user to search for documents that are similar to the document shown in window 907.

ii. **Polnerow**

Polnerow basically discloses an online directory, such as online Yellow Pages. Figure 4, which was cited by the Examiner, is a flow chart of a process for a user to search for a contact. In step 100 the user enters a name, city and/or state to search. The system then searches the contacts database for a matching entry. If a matching entry is found, it is displayed to the user.

III. Discussion

In the subject Office Action, the Examiner alleges that: "Kubota discloses the elements of claim 36 as noted above but does not explicitly disclose, 'contact information'." The Examiner notes that Polnerow discloses "contact information" in Figure 4 and alleges that it would have been obvious to combine the teachings of Polnerow with Kubota "because Polnerow's teaching would have allowed Kubota to provide a look up of contact information based on other contact information provided by the user." Applicants respectfully submit that the combination is improper and fails to disclose all of the claimed elements, and that the Examiner failed to make a *prima facie* case of obviousness.

According to MPEP 2141(II): When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
 - (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
 - (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
 - (D) Reasonable expectation of success is the standard with which obviousness is determined.
- Citing: *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). Applicants respectfully submit that the Examiner failed to adhere to any of the mandated tenets.

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With respect to element (A), rather than considering claim 36 as a whole, the Examiner simply compared "truncated" elements from claim 36, devoid of context and in an incomplete form, so as to morph the claim to resemble Kubota. For example, by removing the term "contact" from the various recitations of claim 36, the Examiner twists the claim language to allegedly read on the "similarity search" feature of Kubota. However, the claim as a whole recites a system that monitors a document currently displayed on the computer, identifies searchable text elements, compares these elements to contacts in a contact database, and notify the user of ranked matched contacts, without disrupting the user's current task on the computer. On the other hand, the "similarity search" feature of Kubota does not monitor the user's document, but rather requires the user to actively click on icon 947 to activate the feature. Then the system searches for similar documents, not for matching contacts.

With respect to element (B), considering the references as a whole, Kubota teaches a search engine, while Polnerow teaches an online directory. Considering the references as a whole, they fail to suggest any desirability for the combination pressed by the Examiner. That is, Kubota provides a system for searching a document database, while Polnerow discloses a system for searching a contact database. Each reference provides a solution to a specified problem, and neither suggests that when a user views a document, the system should search for a corresponding contact. To the contrary, Kubota teaches to search documents matching the user's entry terms or documents similar to the document viewed by the user. Polnerow teaches to search contacts matching name submitted by the user. It is respectfully submitted that no motivation is provided to combine these two references.

The combination suggested by the Examiner can only be made with hindsight, which is impermissible under tenet (C). That is, the desirability to combine the references so as to identify a term in a document per Kubota and search a contact database per Polnerow can only be gained by the hindsight obtained from the subject Application. Nothing in the prior art provides such a motivation. Moreover, even if the teachings of Kubota and Polnerow are

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combined as suggested by the Examiner, it is unclear how the combination of the teachings provides the claimed invention, as per tenet (D). That is, an artisan may be motivated to include the contact database of Polnerow in the system of Kubota. However, that would only provide a system wherein the user may enter a term to search for matching documents or enter a name to search for a matching contact. That system would still fail to disclose monitoring a displayed document, extracting potential contact information, and searching the contact database for matching contacts.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP 2142.

As indicated above, Applicants respectfully submit that no motivation is provided in the art to make the combination suggested by the Examiner. Further, it is not clear how the search engine teachings of Kubota may be combined with the online directory to provide a successful system comparable to what is claimed. Finally, even when the teachings are combined, they fail to teach all of the limitations reciting that a document is monitored to identify search terms, a contact database is searched to find potential contacts, and the relevant contacts are provided to the user. Therefore, the Examiner failed to make a *prima facie* case of obviousness.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

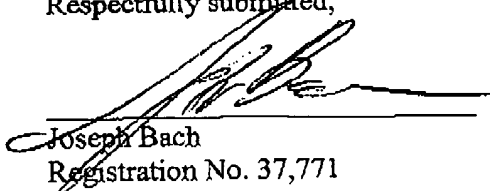
Respectfully submitted,

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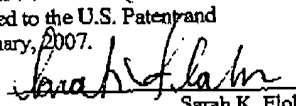
CUSTOMER NUMBER


Joseph Bach
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Date: January 3, 2007

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this PRE-APPEAL BRIEF REQUEST FOR REVIEW is being facsimile transmitted to the U.S. Patent and Trademark Office this 3rd day of January, 2007.


Sarah K. Flohr